

REMARKS

The Office Action mailed November 18, 2004 has been reviewed and the Examiners comments carefully considered. No claims are amended or added. Thus, claims 1-10 remain pending. Claims 4-5 are allowed and claims 1-3 and 6-10 are rejected. Favorable reconsideration of this application in view of the following remarks is respectfully requested.

Claims 1-3 and 6-10 are rejected under 35 U.S.C. §§ 102(e) as anticipated by or, in the alternative, under 103(a) as obvious over U.S. Patent No. 6,290,159 ("Specht"). For the following reasons, both of these rejections are respectfully traversed.

The rejection should be withdrawn because Specht fails to disclose, teach or suggest the claimed invention. For example, Specht fails to disclose, teach or suggest a motorized seat belt retractor "wherein the load limit is controlled using a variable resistor located in series with the motor in an electrical circuit configured to carry a driving current to the motor" as called for in claim 1.

The Examiner contends that "it is deemed inherent that the motor is variable in torque/speed which is effected by a variable current which in turn is effected by a variable resistor." (Office Action at p. 2). To establish inherency, the extrinsic evidence must make clear that the variable resistor is necessarily present in the Specht retractor, and that it would be so recognized by a person of ordinary skill in the art. In re Robertson, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). As there are several ways to provide a variable current, it is clear that a variable resistor is not "necessarily present" in the Specht retractor. Thus, there is no basis for a rejection under 35 U.S.C. § 102(e).

There is also no basis for a rejection under the alternative grounds of 35 U.S.C. § 103, because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 2143. Here, the Examiner has failed to meet any of the three criteria. Nowhere in the Office Action does the Examiner provide any evidence of a motivation to modify Specht to include a variable resistor in series with the motor. Thus, on this basis alone, the rejection under § 103 is defective and should be withdrawn. Furthermore, there is no evidence that the Specht retractor will function with a variable resistor. Finally, the prior art must teach or suggest all of the claim limitations and, as explained above, Specht fails to teach the existence of a variable resistor (either explicitly or inherently) and the Examiner relies on no other evidence of a variable resistor. Thus, there is no *prima facie* case of obviousness and the rejection must be withdrawn.

For the reasons set forth above, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Claims 2, 3 and 6-10 depend from claim 1 and are allowable therewith, for at least the reasons set forth above with regard to claim 1, without regard to the further patentable limitations contained therein.

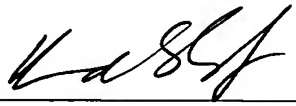
Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would expedite allowance of the application.

Respectfully submitted,

Date: March 18, 2005

FOLEY & LARDNER
Customer Number: 22428
Telephone: (202) 672-5582
Facsimile: (202) 672-5399

By: _____


Howard N. Shipley
Attorney for Applicant
Registration No. 39,370

SHOULD ADDITIONAL FEES BE NECESSARY IN CONNECTION WITH THE FILING OF THIS PAPER, OF IF A PETITION FOR EXTENSION OF TIME IS REQUIRED FOR TIMELY ACCEPTANCE OF SAME, THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE DEPOSIT ACCOUNT NO. 19-0741 FOR ANY SUCH FEES; AND APPLICANT(S) HEREBY PETITION FOR ANY NEEDED EXTENSION OF TIME.
--